

### **REMARKS**

This amendment is submitted in reply to the Office Action dated September 19, 2008. Claims 1-24 currently stand rejected. Applicants have amended independent claims 1, 5, 10 and 15 to more particularly distinguish the claimed invention. Claim 24 has been amended for clarity. Claims 25-27 have been added to further patentably define and distinguish the invention. No new matter has been added by these amendments.

In light of the amendment and the remarks presented herein, Applicant respectfully requests reconsideration and allowance of all now-pending claims of the present application.

### **Claim Objections**

The Office Action objects to Claims 1-4, 10-14 and 24 for various informalities. Claims 1-4, 10-14 and 24 have been amended consistent with the suggestions in the Office Action. Accordingly, Applicant respectfully submits that the objections to Claims 1-4, 10-14 and 24 are overcome.

### **Claims Rejections - 35 U.S.C. §112, first paragraph**

The Office Action rejects Claims 1-24 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. More particularly, the Office Action alleges that the word "image" in the recitation of "wherein the electronic gift certificate is a multimedia message including barcode image data" provided in the claimed invention is not disclosed in the specification and the drawings. Nevertheless, the Office Action acknowledges that the present invention discloses barcode data. Indeed, paragraph 66 and FIG. 6 of the present application, for example, respectively recites and illustrates bar code data displayed, for example, on a communication terminal. As such, it may be implied or suggested that a gift certificate of the present application may be provided with barcode image data. Nevertheless and notwithstanding the explanation provided above, Claims 1, 5, 10 and 15 have been amended to remove any recitation of "image." Accordingly, Applicant respectfully submits that the rejection of Claims 1-24 under 35 U.S.C. §112, first paragraph is overcome.

Appl. No.: 10/528,528  
Amdt. dated 03/10/2009  
Reply to Office actions of 09/19/2008 and 02/26/2009

**Claims Rejections - 35 U.S.C. §103(a)**

The Official Action rejects Claims 1-24 under 35 U.S.C. §103(a) as being unpatentable over of U.S. Patent No. 6,370,514 to Messner (hereinafter the “Messner ‘514 patent”) in view of various combinations with U.S. Publication 2002/0111879 to Melero et al. (hereinafter the “Melero ‘879 publication”), U.S. Patent Application Publication No. 2002/0152176 to Neofytides et al. (hereinafter the “Neofytides ‘176 publication”), *Retailers Mull Pulling Plug on E-Commerce* by Sliwa (hereinafter the “Sliwa article”), *Retailers Report Problems Verifying Gift Certificate Cards* by Benston (hereinafter the “Benston article”), and U.S. Publication 2001/0039589 to Aho et al. (hereinafter the “Aho ‘589 publication”), U.S. Application Publication No. 2003/0018553 to Lindquist (hereinafter the “Lindquist ‘553 publication”), U.S. Patent 7,006,993 to Cheong (hereinafter the “Cheong ‘993 patent”), U.S. Patent Application Publication No. 2002/0087469 to Ganesan et al. (hereinafter the “Ganesan ‘469 publication”), U.S. Patent No. 7,209,889 to Whitfield (hereinafter the “Whitfield ‘889 patent”), U.S. Patent Application Publication No. 2002/0032605 to Lee (hereinafter the “Lee ‘605 publication”), *Ecount Introduces Incentives Program* (hereinafter the “Ecount article”), and U.S. Patent Application Publication No. 2003/0004812 to Kasasaku (hereinafter the “Kasasaku ‘812 publication”).

As explained herein, however, Applicant respectfully submits that the claimed invention is patentably distinct from the Messner ‘514 patent and the various additionally cited references, individually or in combination. In light of the remarks presented below, Applicant respectfully requests reconsideration and allowance of all now-pending claims of the present application, namely Claims 1-24.

Independent claims 1, 5, 10, and 15 are directed to a system and methods for managing sales, gifting, and usage of electronic gift certificates according to requests by a communication terminal through a network. More particularly, independent Claim 1 is directed to a gift certificate service system for managing sales, gifting, and usage of electronic gift certificates

Appl. No.: 10/528,528  
Amdt. dated 03/10/2009  
Reply to Office actions of 09/19/2008 and 02/26/2009

comprising a gift certificate service server, a gift certificate database accessed by the gift certificate service server, and a network server.

By contrast, the Messner '514 patent is directed to a method for marketing and redeeming vouchers for use in online purchases that includes a voucher server for processing the related transactions. In this regard, the voucher server maintains a database of participating merchants, virtual malls, and outstanding purchased vouchers. As such, a purchaser may purchase a voucher that may be delivered to a recipient.

Initially Applicant notes that the Office Action acknowledges that the Messner '514 patent fails to teach or suggest several features of the claimed invention, as evidenced by the number of references cited in addition to the Messner '514 patent. Nevertheless, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness over the alleged combination of the Messner '514 patent and the various cited references even in light of *KSR Int'l. Co.*

In particular, the Office Action acknowledges that the Messner '514 patent fails to teach or suggest that the vouchers are stored prior to their transfer to a transferee but rather discloses that the vouchers are stored on the voucher server only if they have been successfully delivered to a transferee, contrary to the claimed invention wherein electronic gift certificates are stored on a database prior to being transferred to a transferee. See page 5 of the Office Action. Instead the Office Action cites the Neofytides '176 publication for allegedly disclosing such a feature. However, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness over the alleged combination of the Messner '514 patent and the Neofytides '176 publication even in light of *KSR Int'l. Co.*, which requires that any finding of obviousness should be based on an apparent reason to combine the cited reference.

In this regard, there is no reason to modify the Messner '514 patent by the disclosure provided in the Neofytides '176 publication. Applicant acknowledges the Supreme Court's recent decision in which the Court rejected a rigid application of the "teaching, suggestion or

Appl. No.: 10/528,528

Amdt. dated 03/10/2009

Reply to Office actions of 09/19/2008 and 02/26/2009

motivation” (TSM) test. *KSR Int’l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d (BNA) 1385 (2007). Nonetheless, in *KSR Int’l. Co.*, the Court did state that obviousness often requires determining whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue, and that to facilitate review, this analysis should be made explicit. *See KSR Int’l. Co.*, 127 S.Ct. at 1740–41, 82 USPQ2d (BNA) at 1396. Even further, the Court noted that “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S.Ct. at 1740–41, 82 USPQ2d (BNA) at 1396, *citing In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d (BNA) 1329 (Fed. Cir. 2006) (emphasis added).

As clearly explained by the Supreme Court in *KSR Int’l. Co.*, then, any finding of obviousness should be based on an apparent reason to combine the prior art, and must be supported by more than mere conclusory statements. The Office Action attempts to utilize the rationale of “maintaining gift certificates to be transferred as may be desired” in light of the Neofytides ‘176 publication as a reason for storing electronic gift certificate information prior to transferring the gift certificate to a transferee. The Neofytides ‘176 publication is directed to a process for transferring credit from a payor to payees using a wide-area computer network. In this regard, the Office Action cites the disclosure of the Neofytides ‘176 publication relating to storing money as a credit amount as a database entry as teaching or suggesting storing gift certificates in a database prior to their transfer to a transferee. However, as indicated above, the Messner ‘514 patent is directed to a method for marketing and redeeming vouchers in online purchases. The Messner ‘514 patent discloses that the purpose of the voucher server is to track customers’ purchases, or in other words, track customers’ usage of vouchers. In this regard, the purchasing history data is used for marketing purposes (e.g., marketing campaigns, product launches, etc.) for adapting electronic mailers to customers. Accordingly, the Messner ‘514 patent is directed to and concerned with the actual usage of the vouchers which is used for marketing purposes. As such, any modification of the voucher server to enable the storage of vouchers before the vouchers are successfully delivered to a recipient would be superfluous because such a feature would in no way enhance, improve, or be beneficial to the tracking of

Appl. No.: 10/528,528  
Amdt. dated 03/10/2009  
Reply to Office actions of 09/19/2008 and 02/26/2009

customers' purchases to be used in furtherance of marketing purposes. Therefore, Applicant respectfully submits that there is no apparent reason to combine the Messner '514 patent with the Neofytides '176 publication, and that the alleged reasoning provided by the Office Action is merely a conclusory statement that has no basis as a rational underpinning for combining the cited references.

Moreover, Applicant notes that the Office Action acknowledges that the Messner '514 patent fails to teach or suggest that the electronic gift certificate information stored by the gift certificate database includes at least one of gifting history of the gift certificates and usage history of the gift certificates, and instead cites the Benston article for allegedly disclosing such feature. However, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness over the alleged combination of the Messner '514 patent and the Benston article even in light of *KSR Int'l Co.* In this regard, Applicant respectfully asserts, for the sake of the argument but not as an admission, that even if the Benston article were seen to cure the deficiencies of the Messner '514 patent, it would still not be proper to combine the Benston article with the Messner '514 patent because the Benston article is not analogous art. In this regard, under the standard set by the Supreme Court in *KSR Int'l Co.*, the Benston article is not a proper reference. As indicated above, the claimed invention is directed to managing sales, gifting, and usage of electronic gift certificates. Meanwhile, the Benston article is only directed to physical gift cards, such as credit cards. The problems to be addressed in the art of the claimed invention are clearly very different than the problems addressed in the Benston article.

Applicant recognizes that *KSR Int'l Co.* has changed the prior standard with regard to the reliance on references in fields different from that of the claimed invention. In particular, although a reference relied upon under 35 U.S.C. §103 must still be analogous art, as stated in MPEP 2141.01(a) referring to *KSR Int'l Co.*, "a reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." Given the difference between the types of problems faced in the claimed invention as opposed to the problem faced in the Benston article based at least on the

Appl. No.: 10/528,528  
Amdt. dated 03/10/2009  
Reply to Office actions of 09/19/2008 and 02/26/2009

differences between physical gift cards and the electronic gift certificates of the claimed invention, Applicant respectfully submits that there would be no logical reason for one skilled in the art faced with unifying electronic gift certificate management system in the circulation of electronic gift certificates in an online and offline system to consider a reference regarding physical gift cards to be reasonably pertinent. Therefore, the Benston article is also not reasonably pertinent to the particular problem with which the inventor was concerned. Moreover, although the Benston article discloses tracing each card's history via a computer, the Benston article does not teach or suggest how the tracing is performed such as whether the history is stored in a database along with other information associated with the cards. Thus, the Benston article is not analogous art and, therefore, cannot be relied upon to support an obviousness rejection under 35 U.S.C. §103.

Furthermore, as stated in MPEP 2141.01(a) citing *KSR Int'l. Co.*, "any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." However, no reason is even provided by the Office Action in any way illustrating why one of skill in the art of circulating electronic gift certificate in an online and offline system would look to a reference concerned only with physical gift cards. Thus, the Benston article is also not a proper reference since there would be no apparent reason to combine the Messner '514 patent with the Benston article.

None of the other cited references overcome the deficiencies of the Messner '514 patent with respect to the feature allegedly disclosed by the Neofytides '176 publication and the Benston article as discussed above, such that any combination of the Messner '514 patent with the other cited references fail to overcome these same features. Therefore, for at least the foregoing reasons, the Messner '514 patent and the various cited references, individually or in combination, all fail to teach, suggest, or render obvious Claims 1-24.

Nevertheless and notwithstanding these patentable features of the gift certificate database recited in the claims, independent Claim 15 has been further amended to recite "wherein settling

Appl. No.: 10/528,528  
Amdt. dated 03/10/2009  
Reply to Office actions of 09/19/2008 and 02/26/2009

the price with the gift certificate and determining whether the settlement is possible comprises presenting the gift certificate by displaying barcode data on the communication terminal.”

Independent Claims 1, 5, and 10 have been similarly amended.

In this regard, the Messner ‘514 patent fails to teach or suggest the features of amended independent Claims 1, 5, 10, and 15, namely that the electronic gift certificate may be used by displaying the barcode data on the communication terminal. Moreover, none of the additionally cited references overcome the deficiencies of the Messner ‘514 patent with respect to the amended independent claims in that none of the cited references teach or suggest at least this same feature of amended independent Claims 1, 5, 10, and 15, and are not cited for such. For at least the foregoing reasons, Applicant respectfully submits that the Messner ‘514 patent and the additionally cited references, taken individually or in various combinations with each other, fail to teach, suggest, or render obvious independent Claims 1, 5, 10, and 15, and the claims dependent therefrom, namely Claims 2-4 and 24, 6-9, 11-14, 16-23, respectively.

### **C. The Newly Added Claims are Patentable over the cited references**

Applicants have added new Claims 25-27 to more particularly define aspects of the present application. The new claims include no new matter and are fully supported by the specification and the drawings of the present application such as, for example, paragraphs 69, 75 and 88. Claims 25-27 also depend either directly or indirectly from respective ones of independent claims 1 and 15, which are patentably distinct from the cited, and thus include all their respective independent claims. Applicant respectfully submits that the cited references, alone or in combination, all fail to teach or suggest the features of the added new Claims 25-27.

Accordingly, it is believed that the new claims, namely Claims 25-27, are also in condition for allowance.

Appl. No.: 10/528,528  
Amdt. dated 03/10/2009  
Reply to Office actions of 09/19/2008 and 02/26/2009

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that all of the claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



James S. Bennin  
Registration No. 60,692

**Customer No. 00826**  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, NC 28280-4000  
Tel Charlotte Office (704) 444-1000  
Fax Charlotte Office (704) 444-1111

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